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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,789	09/12/2001	Charlie Ricci	018413-378	8809

38706 7590 08/17/2004

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EXAMINER	
SHAREH, SHAHNAM J	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/954,789	RICCI ET AL.	
	Examiner	Art Unit	
	Shahnam Sharareh	1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *16, 20-32*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons of record. Applicant has raised a new argument that Chuter and May are not competent prior art. Examiner has taken the position in the Final rejection that priority of the instant application is March 2000, because earlier parent applications did not meet written description requirement of 35 USC 1121st para. In essence, prior parent application did not envision the use of stent-grafts. Applicant has now provided new arguments that the parent application, SN 09/273,120 now US Patent NO. 6,203,779 incorporated the teachings of Parodi and has contempelated the use of stent-graft. In response Examiner states that the written description standard of 35 USC 112 1st requires a clear description of what does one has "in possession" at the time of invention, not what which makes it obvious. see Lockwood v. American Airlines Inc. , 107 F3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997). In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112. In re Hogan, 559 F.2d 595, 609, 194 U.S.P.Q. (BNA) 527, 540 (CCPA 1977). Entitlement to a filing date does not extend to subject matter which is not disclosed, or would be obvious over what is expressly disclosed. It extends only to that which is disclosed. While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. See Martin v. Mayer, 823 F.2d 500, 504, 3 U.S.P.Q.2D (BNA) 1333, 1337 (Fed. Cir. 1987) quoting Jepson v. Coleman, 50 C.C.P.A. 1051, 314 F.2d 533, 536, 136 U.S.P.Q. (BNA) 647, 649-50 (CCPA 1963)). One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. Id. The applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. Here, applicant's reference to Parodi, is in passing to describe what is the state of art for treating aneurysm, not what is in possession of the inventor at the time of invention. Throughout the prosecution, Applicant has argued that Stent-grafts are different from other prosthesis in the art for treating AAA. Accordingly, absence of clear statement in the parent cases for envisioning the use of Stent-grafts in the embolizing kit, the use of such grafts would not have been contemplated at the time of filing. The parent cases do not clearly describe and convey to those of skilled in the art, that the kits with stent-grafts was in possession of the inventor at the time filing. Applicant's arguments merely amounts to a statement that it would have been obvious to use stent-grafts in the kits disclosed in US Patent 6,203,779. However, such line of reasoning does not meet the written description standard of 35 USC 112 1st as described in Lockwood. Thus, Examiner maintains his position that the priority of this application is March 19, 2000 .